

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No: 10/572,754
Applicants: Xian-Ming Zeng et al.
Filed: April 11, 2007
Title: PARTICLES
TC/A.U.: 1616
Examiner: Hong Yu
Confirmation No.: 3414
Docket No.: TEVE-113US

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S I R :

This is in response to the Restriction and Election of Species Requirements stated in the Office Action dated August 4, 2009.

The Examiner requires that claims of either Group I (claims 1-19, drawn to particles for drug delivery by inhalation comprising at least one non-crystalline active ingredient); Group II (claims 20-43, drawn to an inhalation composition comprising particles which incorporate at least one active non-crystalline ingredient); or Group III (claims 44-46, drawn to an inhaler device comprising the inhalation composition) be elected for prosecution. The applicants elect to prosecute the claims of Group I (claims 1-19). This election is made with traverse in that the applicants reserve the right to contend that the claims of the three groups do share the same or corresponding special technical feature and that U.S. Patent No. 6,290,991 does not disclose such a special technical feature. In any event, the

applicants have elected for prosecution claims drawn to a particle, and claims directed to the composition (of Group II) and to the inhaler (of Group III) are written in a way which require all the limitations of at least one particle claim. Accordingly, the applicants retain the right to rejoin the claims directed to non-elected groups II and III in the event of an allowable claim in the elected group.

Two election of species requirements have also been made as follows:

- I. Various shapes of particles in claims 5-11 and 32-37;
- II. Various combinations of active ingredients in claims 16-18 and 40-43.

Turning to the first election of species requirement, the applicants respectfully submit that this election of species is improper in that it has identified two claims which are not directed to "various shapes of particles." More specifically, claims 9 and 10 specify only limitations directed to particle size. Similarly, claims 36 and 37 also recite only limitations directed to particle size. Accordingly, the applicants submit that those claims should not be made part of the election of species of "various shapes of particles." In any event, the applicants elect the species recited in claim 5 (and 32), namely that the particles are substantially spherical.

Turning to the second election of species, the applicants elect the species of claim 17 (and 40), namely comprising fluticasone dipropionate and salmeterol xinafoate. Claim 16 is generic to both species of claims 17 and 18. Also, Group I does not have claims corresponding to claims 42 and 43.

All claims are believed to be generic to claim 1. The claims readable on the elected species of Species I include claims 1-6, 9, 10, and 12-19. The claims readable on the elected species of Species II include claims 1-17 and 19. Therefore, claims readable on both species are claims 1-6, 9, 10, 12-17, and 19.

Accordingly, the applicants respectfully request examination on the merits of claims 1-6, 9, 10, 12-17, and 19.

Respectfully submitted,



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Attorney for Applicant Under 37 C.F.R. § 1.34

CRL/lrb

Dated: September 4, 2009

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